



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/544,112

08/02/2005

Takanori Miyoshi

Q88453

9429

23373 7590 08/31/2007  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

CHRISS, JENNIFER A

ART UNIT

PAPER NUMBER

1771

MAIL DATE

DELIVERY MODE

08/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/544,112	<b>Applicant(s)</b> MIYOSHI ET AL.	
	<b>Examiner</b> Jennifer A. Chriss	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/23/2005, 08/02/2005</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group 1, claims 1 – 10, in the reply filed on 8/21/07 is acknowledged. Applicant has indicated that the election is without traverse but also Applicant indicates that Group II, claims 11 – 13, should be rejoined based on the amendment to claim 11. However, because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 – 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hobbs et al. (US 2002/0192449 A1).

Hobbs et al. is directed to aliphatic polyester microfibers (Title) suitable for various end uses such as wound dressings, disposable products and geotextiles (page 1, [0001]).

As to claim 1, Hobbs et al. teach an aliphatic polyester microfibers having an average effective diameter less than 20 microns (page 1, [0010]); the Examiner submits that this range anticipates Applicant's claimed average fiber diameter range. Hobbs et

al. teach that blends of polylactic acid and one or more polymers such as polyethylene glycol are suitable for making the microfibers (page 3, [0034]). The Examiner equates the polylactic acid to Applicant's "hydrophobic solvent-soluble polymer"; it should be noted that in Applicant's Specification on page 7, lines 1 – 15, it is indicated that polylactic acid is a type of hydrophobic solvent-soluble polymer. The Examiner equates the polyethylene glycol to Applicant's "organic compound having a plurality of hydroxyl groups"; it should be noted that in Applicant's Specification on page 7, lines 34 – 35 and page 8, lines 1 – 10, it is indicated that polyethylene glycol is an organic compound having a plurality of hydroxyl groups. Hobbs et al. teach that the microfibers may be prepared from microvoided films (page 3, [0038]), wherein the microvoid content is in excess of 5% (page 4, [0042]); the Examiner equates this to Applicant's "void percentage of at least 5%".

As to claim 2, Hobbs et al. teach the claimed invention above. It should be noted that Hobbs et al. teach the use of polylactic acid (page 3, [0034]) which is noted above as a "hydrophobic solvent-soluble polymer". It should be noted that the presence of a halogen element-containing hydrocarbon is not actually required by the claim, only that the polymer is soluble in that solvent.

As to claim 3, Hobbs et al. teach the claimed invention above. It should be noted that the presence of a specific halogen element-containing hydrocarbon is not actually required by the claim, only that the polymer is soluble in that solvent.

As to claim 4, Hobbs et al. teach that blends of polylactic acid are suitable for making the microfibers (page 3, [0034]).

As to claim 5, Hobbs et al. teach that Applicant's "organic compound" can be polyethylene glycol (page 3, [0034]). It should be noted that on page 7 of Applicant's Specification on lines 27 – 33 that "an example of the organic compound having a molecular weight of 62 and a plurality of hydroxyl groups is ethylene glycol"; the Examiner submits that polyethylene glycol meets Applicant's claim requirements.

As to claim 6, Hobbs et al. teach an aliphatic polyester microfibers having an average effective diameter less than 20 microns (page 1, [0010]); the Examiner submits that this range anticipates Applicant's claimed average fiber diameter range. Hobbs et al. teach that blends of polylactic acid and one or more polymers such as polyethylene glycol are suitable for making the microfibers (page 3, [0034]). The Examiner equates the polylactic acid to Applicant's "hydrophobic solvent-soluble polymer"; it should be noted that in Applicant's Specification on page 7, lines 1 – 15, it is indicated that polylactic acid is a type of hydrophobic solvent-soluble polymer. The Examiner equates the polyethylene glycol to Applicant's "organic compound having a plurality of hydroxyl groups"; it should be noted that in Applicant's Specification on page 7, lines 34 – 35 and page 8, lines 1 – 10, it is indicated that polyethylene glycol is an organic compound having a plurality of hydroxyl groups. Hobbs et al. teach that the microfibers may be prepared from microvoided films (page 3, [0038]), wherein the microvoid content is in excess of 5% (page 4, [0042]); the Examiner equates this to Applicant's "void percentage of at least 5%". Hobbs et al. teaches that the fibers are suitable for various end uses such as wound dressings, disposable products and geotextiles (page 1, [0001]); the Examiner submits that these constitute Applicant's "fiber structure".

As to claim 7, Hobbs et al. teach the claimed invention above. It should be noted that Hobbs et al. teach the use of polylactic acid (page 3, [0034]) which is noted above as a “hydrophobic solvent-soluble polymer”. It should be noted that the presence of a halogen element-containing hydrocarbon is not actually required by the claim, only that the polymer is soluble in that solvent.

As to claim 8, Hobbs et al. teach the claimed invention above. It should be noted that the presence of a specific halogen element-containing hydrocarbon is not actually required by the claim, only that the polymer is soluble in that solvent.

As to claim 9, Hobbs et al. teach that Applicant’s “organic compound” can be polyethylene glycol (page 3, [0034]). It should be noted that on page 7 of Applicant’s Specification on lines 27 – 33 that “an example of the organic compound having a molecular weight of 62 and a plurality of hydroxyl groups is ethylene glycol”; the Examiner submits that polyethylene glycol meets Applicant’s claim requirements.

As to claim 10, Hobbs et al. teach that blends of polylactic acid are suitable for making the microfibers (page 3, [0034]).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Chriss whose telephone number is 571-272-7783. The examiner can normally be reached on Monday - Friday 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571 - 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer A Chriss/  
Examiner, Art Unit 1771  
August 29, 2007